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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,136	07/29/2003	Michael J. Hubbard	GT-4751	6579

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EXAMINER
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HARAN, JOHN T

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/629,136

Applicant(s)

HUBBARD ET AL.

Examiner

John T. Haran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to the amendment and arguments filed on 5/27/04.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Hollis (U.S. Patent 4,337,112) taken with McCarville et al (U.S. Patent 4,931,126) and Cardinal (U.S. Patent 4,050,972).

The admitted prior art teaches it was known in the art to apply four feet wide rolls of cured EPDM roofing membrane to a roof and to splice (seam) adjacent overlapping sheets of cured EPDM roofing membrane together. The admitted prior art also teaches that this process is highly labor intensive and that applying cured EPDM roofing membrane in four feet wide strips to typical roofs that are 200 feet by 400 feet takes a long time and is expensive because of the related labor costs (Specification, pages 1-2).

Hollis is directed to a method for making a composite roofing membrane of indefinite length and a predetermined width in order to expedite the process of applying roofing membrane to a typical roof that is 200 feet by 400 feet by applying the roofing membranes in rolls that are forty feet wide rather than the conventional rolls that are four feet wide (Column 1, lines 11-41). It would have been obvious to one of ordinary

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skill in the art at the time the invention was made to make a composite roofing membrane of cured EPDM membrane of predetermined width and indefinite length in the method of the admitted prior art, as suggested in Hollis, in order to expedite the process of applying roofing membrane to a roof and to lower the labor costs.

One skilled in the art would have readily recognized that it would have been within the purview of one skilled in the art to choose the particular method utilized for forming such a composite sheet of indefinite length and predetermined width from conventional methods. One skilled in the art would have readily appreciated that it is well known and conventional in the sheet handling art to either form a composite sheet of indefinite length and predetermined width with a single supply roll wherein pieces of sheet are pulled out and cut and then laterally moved to overlap another cut sheet and seamed together as shown for example in Hollis (Column 1, lines 12-67 and Column 10, lines 36-44) or to form a composite sheet with a plurality of supply rolls arranged so that the sheets are pulled out in an overlapping manner and continuously seamed together as shown for example in McCarville et al (Column 2, line 59 to Column 3, line 7) or Cardinal (Column 1, lines 29-40). The two methods are alternative expedients, obvious over one another, for forming a composite sheet of indefinite length and predetermined width. Additionally, one skilled in the art would have readily appreciated that forming a composite sheet by providing a plurality of supply rolls arranged so that the sheets are pulled out in overlapping manner and continuously seamed together has the advantage of being quicker and more efficient since the overlapping edges can be continuously seamed unlike the option taught in Hollis. It would have been obvious to one of ordinary

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skill in the art at the time the invention was made to make a composite roofing membrane of cured EPDM membrane of predetermined width and indefinite length in the method of the admitted prior art, as suggested in Hollis, and to make the composite by providing a plurality of rolls of cured EPDM membrane, simultaneously feeding the EPDM membranes in a first direction wherein the edges of the EPDM membranes are in overlapping relationship, and continuously seaming the overlapping edges together to form a composite roofing membrane of indefinite length as is well known and conventional in the sheet handling art as evidenced by McCarville et al and Cardinal.

Regarding claim 8, one skilled in the art would have readily appreciated cutting the cured EPDM membrane to a desired length in order to have a composite roofing membrane of a desired length and it would have been obvious to do so.

4. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Hollis (U.S. Patent 4,337,112) taken with McCarville et al (U.S. Patent 4,931,126) and Cardinal (U.S. Patent 4,050,972) as applied to claim 1 above, and further in view of Davis (U.S. Patent 5,545,685).

As noted above the admitted prior art teaches splicing (seaming) cured EPDM but is silent towards the exact method utilized.

Davis et al is directed to a method for bonding cured EPDM membranes together. Davis et al teach that it is well known and conventional to use cured EPDM membranes for covering roofs and that it is necessary to form a seam in the areas of overlapping cured EPDM roof sheeting (Column 1, lines 35-55). The reference also

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teaches that it is known to apply adhesive between the overlapping cured EPDM roofing sheets and that it is often necessary to apply heat and pressure to obtain good adhesion (Column 2, lines 19-39). One skilled in the art would have readily appreciated using conventional means for seaming cured EPDM together in the method of the admitted prior art, as modified above.

Regarding claims 2-3, Davis teaches bonding the cured EPDM membranes with adhesive and one skilled in the art would have readily appreciated that the adhesive is either applied before or after overlapping and that the two are alternate expedients obvious over one another. It would have been obvious to do either.

Regarding claims 4-5, Davis teaches the adhesive can be thermoplastic polyolefin or thermoplastic elastomer (See Column 4, line 63 to Column 5, line 35).

Regarding claims 6-7, Davis teaches seaming the cured EPDM membranes together with adhesive under heat and pressure.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable Subject Matter***

6. Claim 19 is allowed.

7. The following is an examiner's statement of reasons for allowance:

As noted by Applicant, claim 19 is allowed for the same reasons described by the Board of Appeals in their decision dated March 20, 2003 with regards to the apparatus for performing the method of claim 19 in related application 09/197,140, now U.S. Patent 6,615,892.

8. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

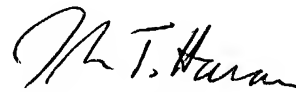
#### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John T. Haran** whose telephone number is **(571) 272-1217**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John T. Haran  
Examiner  
Art Unit 1733